Office-Supreme Court, U.S.
FILED
SEP 9 1963
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IN THE

Supreme Court of the United States

OCTOBER TERM 1963

No. 352

THE DUCTLESS HOOD CO., INC., NEW MILFORD CONSTRUCTION AND REPAIR COMPANY and GEORGE A. SCHARMER,

Petitioners,

v.

A & B HOME APPLIANCES, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

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This is a conventional suit for infringement of a patent relating to a kitchen stove hood.

The trial court below found, from all the evidence, that petitioners' patent covers an obvious expedient rather than a patentable invention and held the patent invalid for lack of invention over the prior art. The Court of Appeals for the Second Circuit in a per curiam opinion affirmed on the same ground. Petitioners now seek a further review of the trial court's obviousness finding.

Like all other patent owners who have ever had their patents held invalid for lack of invention, petitioners believe that the courts below ignored the statutory presumption of validity, failed to give enough weight to the evidence favor-

able to their side, and employed too severe a test of invention.

However, there is complete unanimity by the courts below that the patent is invalid; there is no conflict of decisions between Circuits, and there is no valid reason for granting certiorari.

ARGUMENT

The alleged invention was succinctly described by the Court of Appeals:

> "The advancement claimed by the plaintiffs for their 'invention' is the relocation of air outlets from the top to the front of a kitchen exhaust hood." (Petition p. 12).

Petitioners do not, indeed cannot, challenge this description, but rather simply argue that the court's finding of obviousness of this "relocation" in view of the prior art Somntag patent was erroneous (Petition p. 2, Question 2). The Court of Appeals' logic on this point needs no embellishment:

> "If the top of the hood is to be covered by cabinets—the situation for which plaintiffs' product was designed—the obvious answer is moving the louvres. This hardly shows invention." (Petition p. 12).

The evidence, including testimony of the plaintiff inventor himself, supported this finding of obviousness (D. App. 2b, 3b; P. App. 78a)[1] and the District Court correctly so held (Petition p. 16).

[1] D. App. and P. App. designate respectively defendant's respondent's and plaintiffs'-petitioners' appendices in the court below. The Appendix record is filed for consideration by this Court as Volume I, Appendix for Plaintiffs-Appellants and Volume II, Appendix for Defendant-Appellee together with proceedings in the Circuit Court of Appeals.

The courts below, in holding the patent invalid, applied the proper standard of invention as set forth in the applicable decisions of this Court, *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549 (1938) and *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, 152 (1950), the District Court specifically holding:

> "So much Scharmer's flood includes and it shares each of these elements and their union with the prior art—and these elements are the operative ones. That is: Scharmer did not devise a method for purifying and recirculating kitchen air. Scharmer did not bring primary elements sold or new to the makeup of the operative combination of elements. And Scharmer did not introduce a new method of combining the primary elements of this known combination or impose on them any new primary rule of action." (Petition p. 15)

Lastly, one contention of petitioners deserves a brief answer, that in placing reliance upon the prior art Santag patent—a file wrapper reference—the courts below, exceeded "the appropriate scope of [the] review of a Patent Office determination". (Petition, p. 6)

The mere citation of a prior art reference by the Patent Office Examiner during the prosecution of an application for a patent does not immunize the patent from subsequent invalidation for lack of invention over the disclosure of that reference. The statutory presumption being rebuttable, it is the standard of invention and not the decision of the Patent Office that controls. *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, 150. Here, in applying that standard, the trial court gave careful consideration to the fact that the Patent Office had cited the Santag patent and concluded that the Patent Office made a "mistake"

in accepting "a difference in arrangement as invention" (Petition p. 18).

CONCLUSION

The decision of the Court of Appeals is correct and in conformity with the applicable decisions of this Court. There is no valid basis for review by this Court. Accordingly, the petition for certiorari should be denied.

Respectfully submitted,

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